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wherein the dielectric material has a capacity, upon creation of a discontinuity in the at least one insulating layer, of reestablishing a continuity in the at least one insulating layer in a reversible manner.--

REMARKS

I. Preliminary Remarks

Applicants amend the present application to copy claims from the '231 patent, and to request one interference with both the '473 and '231 patents. The '473 and '231 patents are both assigned on their face to the Southwire Company, Carrollton, Georgia.

This Second SPA fulfills the requirements of 37 C.F.R. §§ 1.604 and 1.607. Two proposed Forms PTO-850 (Interference Initial Memorandum) accompany this paper to expedite the declaration of an interference. Applicants respectfully request that prompt attention be given to this request for an interference.

II. Status of the Claims

After entry of this Second SPA, claims 55-100 are pending in the present application. The following explains the status of all claims introduced in this application.

The originally-filed papers of the present application included, inter alia, a specification, a Preliminary Amendment (and associated Appendix), and an SPA. The specification included originally-filed claims 1-54. The Preliminary Amendment canceled, without prejudice or

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disclaimer, claims 2-54. The SPA canceled, without prejudice or disclaimer, claim 1 and added new claims 55-73.¹

This Second SPA now adds new claims 74-100. New claims 74-99 have been copied identically² from the '231 patent and correspond, respectively, to claims 1-26 of the '231 patent. New claim 100 is directed to the same subject matter as new claim 97 (and claim 24 of the '231 patent), differing so as to improve the clarity of the claim language. The specification of the present application supports new claims 74-100 as indicated, for example, in the attached "Claim Chart—Part II" (Exhibit B).

III. Benefit and Right of Priority

The present application is a continuation of U.S. patent application Serial No. 09/971,766 ("the '766 application"), filed October 9, 2001, in the name of Sergio BELLI et al. The '766 application is a continuation of U.S. patent application Serial No. 09/261,505 ("the '505 application"), filed March 3, 1999, also in the name of Sergio BELLI et al. In the present application, Applicants claim the benefit under 35 U.S.C. § 120 of both the '766 application and the '505 application.

¹ On June 10, 2002, the USPTO mailed a Notice of Non-Compliant Amendment ("Notice"). The Notice did not specify, and the undersigned Applicants' representative was unable to determine, whether the Notice applied to the Preliminary Amendment (and associated Appendix) or to the SPA. In a good-faith effort to comply with the Notice, Applicants submitted a Substitute Preliminary Amendment (and associated Substitute Appendix). Similar to the Preliminary Amendment, the Substitute Preliminary Amendment canceled, without prejudice or disclaimer, claims 2-54.

² Two typographical errors in claims 11 and 25 of the '231 patent are corrected in respective new claims 84 and 98: (1) "migrates" in claim 11 is corrected to recite "mitigates" in claim 84; and (2) "filing" in claim 25 is corrected to recite "filling" in claim 98.

Additionally, through the '766 application and the '505 application, Applicants claim the benefit under 35 U.S.C. § 119(e) based on prior-filed, copending provisional application No. 60/076,752 ("the '752 provisional application"), filed March 4, 1998, in the U.S. Patent and Trademark Office ("USPTO"). Similarly, through the '766 application and the '505 application, Applicants claim the right of priority under 35 U.S.C. § 119(a) - (d) based on patent application No. 98103767.4 ("the EP application"), filed March 4, 1998, in the European Patent Office.

Accordingly, Applicants submit that the present application is entitled to an effective filing date of no later than March 4, 1998.

IV. Request That an Interference Be Declared

The SPA requested that an interference be declared between claims 55-73 of the present application and claims 1-18 of the '473 patent. The SPA also requested that an interference be declared between the present application and any claims of the '533 application directed to the same patentable invention as claims 55-73 of the present application. Additionally, the SPA requested that an interference be declared between claims 55-73 of the present application and any pending patent applications that claim the benefit of the '473 patent and contain claims for the same patentable invention as the present application. Because the '533 application issued as the '231 patent on March 19, 2002, Applicants submit this Second SPA to include the claims of the '231 patent into the request for interference.

An interference is appropriate between an application and an unexpired patent or other application owned by a different party when the application and the patent or other application contain claims for the same patentable invention. 37 C.F.R. § 1.601(i). The test for ascertaining

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if claims are directed to the same patentable invention is set forth in 37 C.F.R. § 1.601(n) as follows:

Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A".

Under this test, an interference should be declared between claims 55-73 of the present application and claims 1-18 of the '473 patent (Exhibit C). Because claims 55-72 of the present application are identical³ to claims 1-18 of the '473 patent, and because claim 73 is directed to exactly the same subject matter as claim 70 of the present application and claim 16 of the '473 patent, the claims herein are directed to the "same patentable invention" as the claims of the '473 patent. Moreover, because claims 55-73 of the present application are directed to the same patentable invention as the claims of the '473 patent, claims 55-73 are allowable over the prior art for the same reasons that the USPTO found the claims of the '473 patent to be allowable over the prior art. Claims 55-72 have been copied identically from the '473 patent. As a result, representative comparisons of the claims of the '473 patent to the claims of the present application are not necessary.

Additionally, under the test of 37 C.F.R. § 1.601(n), an interference should be declared between claims 74-100 of the present application and claims 1-26 of the '231 patent (Exhibit D). Because claims 74-99 of the present application are identical to claims 1-26 of the '231 patent, and because claim 100 is directed to exactly the same subject matter as claim 97 of the present

³ Two typographical errors in claims 16 and 17 of the '473 patent are corrected in respective new claims 70 and 71: (1) "polysobutene" in claim 16 is corrected to recite "polyisobutene" in claim 70; and (2) "filing" in claim 17 is corrected to recite "filling" in claim 71.

application and claim 24 of the '231 patent, the claims herein are directed to the "same patentable invention" as the claims of the '231 patent. Moreover, because claims 74-100 of the present application are directed to the same patentable invention as the claims of the '231 patent, claims 74-100 are allowable over the prior art for the same reasons that the USPTO found the claims of the '231 patent to be allowable over the prior art. New claims 74-99 have been copied identically from the '231 patent. As a result, representative comparisons of the claims of the '231 patent to the claims of the present application are not necessary.

Further, an interference should be declared between claims 55-100 of the present application and any pending patent applications that both claim the benefit of the '473 patent and/or the '231 patent and contain claims for the same patentable invention as the present application.

For the reasons discussed in the following section, Applicants submit that one interference should be declared.

V. Proposed Count

Applicants seek to provoke one interference between the present application and the '473 patent, between the present application and the '231 patent, and between the present application and any pending patent applications that both claim the benefit of the '473 patent and/or the '231 patent and contain claims for the same patentable invention as the present application.

Applicants, therefore, propose the following count, encompassing the subject matter of each independent claim in the '231 and '473 patents:

Proposed Count

An apparatus according to claim 55 of the present application

or

A method according to claim 59 of the present application

or

A method according to claim 70 of the present application

or

A method according to claim 72 of the present application

or

A method according to claim 73 of the present application

or

An apparatus according to claim 74 of the present application

or

A method according to claim 84 of the present application

or

A method according to claim 97 of the present application

or

A method according to claim 99 of the present application

or

A method according to claim 100 of the present application.

A. Alternatives Recited in the Proposed Count

Ten alternatives are recited in the proposed count.

First, an apparatus according to claim 55 of the present application (and claim 1 of the '473 patent). Second, a method according to claim 59 of the present application (and claim 5 of

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the '473 patent). Third, a method according to claim 70 of the present application (and claim 16 of the '473 patent). Fourth, a method according to claim 72 of the present application (and claim 18 of the '473 patent). Fifth, a method according to claim 73 of the present application. Sixth, an apparatus according to claim 74 of the present application (and claim 1 of the '231 patent). Seventh, a method according to claim 84 of the present application (and claim 11 of the '231 patent). Eighth, a method according to claim 97 of the present application (and claim 24 of the '231 patent). Ninth, a method according to claim 99 of the present application (and claim 26 of the '231 patent). Tenth, a method according to claim 100 of the present application.

Applicants note that, in accordance with common practice in the USPTO, the proposed count includes each of the broadest patentable/valid claims of the present application, the '473 patent, and the '231 patent. Additionally, because of this construction, the proposed count should not encompass unpatentable subject matter in the view of the USPTO.

B. A Single Count Is the Correct Approach

The proposed count recites one invention, i.e., an electrical cable and methods for making the electrical cable, for imparting to the electrical cable a capacity of reestablishing continuity, and of (or for) manufacturing the electrical cable.

Claim 55 recites an electrical cable consisting essentially of a conductor, a layer of insulation around said conductor and a material flowable at about 25° C. between the conductor and the layer of insulation which provides self-sealing properties to the cable, wherein said material is a dielectric and has capacity, upon creation of discontinuity in the layer of insulation, of reestablishing continuity in the layer of insulation in a reversible manner, wherein said material is polyisobutene.

Claim 59 recites a method of making an insulated electrical cable having empty spaces formed during or after a cable manufacturing process, but before installing the cable which mitigates the effects of voids, punctures, or cracks formed in an insulation prior to installation of the cable, during an installation of the cable, and after the cable is placed in service comprising the steps of:

(a) forming a conductor

(b) applying a layer of dielectric material flowable at about 25° C. which provides self-sealing properties on the exterior of the conductor, wherein the material is polyisobutene; and

(c) forming an insulation layer around the conductor.

Claim 70 recites a method for imparting to a cable comprising a conductor, at least one insulating layer, and a material having a capacity of self-repairing the at least one insulating layer, the method comprising providing the cable with an inner layer comprising said material having the capacity, upon creation of a discontinuity in the at least one insulating layer, of reestablishing a continuity in the at least one insulating layer in a reversible manner, and wherein the material is polyisobutene.

Claim 72 recites a method of manufacturing a cable having a layer of self-repairing material, which has a capacity, upon creation of a discontinuity in an insulating layer, of reestablishing continuity in the insulating layer in a reversible manner, comprising the steps of:

(a) depositing the self-repairing material, maintained in a fluid state, on a cable core;

wherein the self-repairing material is polyisobutene, and

(b) forming the layer of self-repairing material so as to obtain a uniform layer of a predetermined thickness.

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Claim 73 recites a method for imparting a self-repairing capacity to a cable, wherein the cable comprises:

a conductor;

at least one insulating layer; and

a material having a capacity of self-repairing the at least one insulating layer;

the method comprising providing the cable with an inner layer comprising a material having the capacity, upon creation of a discontinuity in the at least one insulating layer, of reestablishing a continuity in the at least one insulating layer in a reversible manner, wherein the material is polyisobutene.

Claim 74 recites an electrical cable consisting essentially of a conductor, a layer of insulation around said conductor and a material flowable at about 25° C. between the conductor and the layer of insulation which provides self-sealing properties to the cable and wherein said material is a dielectric that does not substantially absorb moisture or swell upon contact with moisture having capacity, upon creation of a discontinuity in the layer of insulation of reestablishing continuity in the layer of insulation in a reversible manner.

Claim 84 recites a method of making an electrical cable which mitigates the effects of voids, puncture, or cracks formed in an insulation layer prior to installation of the cable, during the installation of the cable, and after the cable is placed in service comprising the steps of:

(a) forming a conductor,

(b) applying a layer of material flowable at about 25° C. which provides self-sealing properties on the exterior of the conductor; and

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(c) forming an layer of insulation around the conductor wherein said material is a dielectric that does not substantially absorb moisture or swell upon contact with moisture, has capacity, wherein upon creation of a discontinuity in the layer of insulation in the cable, the material will reestablish continuity in the layer of insulation of the cable in a reversible manner.

Claim 97 recites a method for imparting to a cable comprising a conductor and at least one insulating layer having a capacity of self-repairing the at least one insulating layer, the method comprising providing the cable with an inner layer comprising a dielectric material that does not substantially absorb moisture or swell upon contact with moisture is flowable at about 25° C. and has the capacity, upon creation of a discontinuity in the at least one insulating layer, of reestablishing the continuity in the at least one insulating layer in a reversible manner.

Claim 99 recites a method for manufacturing a cable having a layer of self-repairing material, comprising the steps of:

- (a) depositing the self-repairing material, maintained in a fluid state, on a cable core; and
- (b) forming the layer of self-repairing material so as to obtain a uniform layer of predetermined thickness wherein said material is a dielectric that does not substantially absorb moisture or swell upon contact with moisture, is flowable at about 25° C. and has capacity, wherein upon creation of a discontinuity in a layer of an insulation in the cable, the material will reestablish continuity in the layer of insulation of the cable in a reversible manner.

Claim 100 recites a method for imparting a self-repairing capacity to a cable, wherein the cable comprises:

- a conductor; and
- at least one insulating layer;

the method comprising providing the cable with an inner layer comprising a dielectric material;

wherein the dielectric material does not substantially absorb moisture or swell upon contact with moisture,

wherein the dielectric material is flowable at about 25 °C, and

wherein the dielectric material has a capacity, upon creation of a discontinuity in the at least one insulating layer, of reestablishing a continuity in the at least one insulating layer in a reversible manner.

1. All Claims of the Present Application, the '473 Patent, and the '231 Patent Correspond to the Proposed Count

Because the proposed count is equal to the broadest patentable/valid claims of the present application, the '473 patent, and the '231 patent corresponding to the proposed count, stated in the alternative, all claims of the present application, the '473 patent, and the '231 patent may correspond to the proposed count. Moreover, for reasons discussed below, all claims of the present application, the '473 patent, and the '231 patent do correspond to the proposed count because none of the claims is patentably distinct over the independent claims set forth in the alternative in the proposed count.

For the Examiner's consideration, Applicants also note that the '766 application, which is the parent of the present application, is pending and may claim subject matter deemed at least relevant to the proposed count.

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2. For the Present Application and the '473 Patent, the Claimed Methods of Making the Cable, for Imparting to the Cable a Capacity of Reestablishing Continuity, and of Manufacturing the Cable Are Not Patentably Distinct from the Cable

The present application and the '473 patent contain both method claims and apparatus claims. By consistently treating all claims of the '473 patent as a single invention during prosecution, the actions of both the '473 patent applicants and the Examiner indicate that the method claims are not patentably distinct from the apparatus claims.

In particular, the '473 patent issued from U.S. patent application Serial No. 09/228,482 ("the '482 application"), in which the Examiner permitted the presence of both apparatus and method claims. During prosecution of the '482 application, the '473 patent applicants submitted apparatus claims directed to the cable and method claims directed to a method of making the cable, a method for imparting to the cable a capacity of reestablishing continuity, and a method of manufacturing the cable. In response, the Examiner did not issue a restriction requirement. Instead, the Examiner eventually mailed a Notice of Allowability, indicating that claims directed to the cable, the method of making the cable, the method for imparting to the cable a capacity of reestablishing continuity, and the method of manufacturing the cable would all issue in the same patent.

The Examiner's Statement of Reasons for Allowance confirms that the apparatus claims are not patentably distinct from the method claims. It states:

This invention deals [with an] electrical cable comprising a conductor, a layer of insulation, and a material flowable at about 25°C between the conductor and insulation layer which provides self-sealing properties to the cable wherein the material is polyisobutene (claim 1) and a method of producing an electrical cable having the self-sealing material which is polyisobutene

(claims 10, 26, & 28) which is not taught or suggested by the prior art of record.

(Notice of Allowability, the '473 patent, § 5, p. 4). The '473 patent applicants did not contest the Examiner's characterization of all eighteen claims in the singular as "[t]his invention."

Thus, the actions of both the '473 patent applicants and the Examiner indicate that the claimed methods are not patentably distinct from the claimed cable.

3. Additional Limitations in the Claims of the Present Application and the '473 Patent Do Not Make Those Claims Patentably Distinct

The dependent claims of the present application and the '473 patent are not patentably distinct from the independent claims of the proposed count. Recitations in these dependent claims include: (1) "the conductor is formed by a plurality of wires stranded together"; (2) "applying a water barrier material over the conductor before applying the self-sealing material in step (b)"; (3) "the water barrier is a polymer sheet"; (4) "said material has a 100 gram needle penetration value greater than 100 tenths of a millimeter at 25° C"; and (5) "the material is capable of at least partially [filling] the discontinuity without leaking from the cable in an uncontrolled manner."

Forming a conductor as a plurality of wires stranded together, applying a water barrier material to a conductor before applying further coating layers, and the use of a polymer sheet as such a water barrier are well known in the art. Also, it is known in the art that polyisobutene may have a 100 gram needle penetration value greater than 100 tenths of a millimeter at 25°C (see, e.g., U.S. Patent No. 5,010,209 and Exhibit E). Further, if the material has capacity, upon creation of discontinuity in the layer of insulation, of reestablishing continuity in the layer of

insulation in a reversible manner, then the material must be capable of at least partially filling the discontinuity without leaking from the cable in an uncontrolled manner.

Additionally, analogous to the discussion in Section V.B.2 above, by consistently treating all claims of the '473 patent as a single invention during prosecution, the actions of both the '473 patent applicants and the Examiner indicate that the dependent claims are not patentably distinct from the independent claims.

4. For the Present Application and the '231 Patent, the Claimed Methods of Making the Cable, for Imparting to the Cable a Capacity of Reestablishing Continuity, and for Manufacturing the Cable Are Not Patentably Distinct from the Cable

The present application and the '231 patent contain both method claims and apparatus claims. By consistently treating all claims of the '231 patent as a single invention during prosecution, the actions of both the '231 patent applicants and the Examiner indicate that the method claims are not patentably distinct from the apparatus claims.

In particular, the '231 patent issued from the '533 application, in which the Examiner permitted the presence of both apparatus and method claims. During prosecution of the '533 application, the '231 patent applicants submitted apparatus claims directed to the cable and method claims directed to a method of making the cable, a method for imparting to the cable a capacity of reestablishing continuity, and a method for manufacturing the cable. In response, the Examiner did not issue a restriction requirement. Instead, the Examiner eventually mailed a Notice of Allowability, indicating that claims directed to the cable, the method of making the cable, the method for imparting to the cable a capacity of reestablishing continuity, and the method for manufacturing the cable would all issue in the same patent.

The Examiner's Statement of Reasons for Allowance confirms that the apparatus claims are not patentably distinct from the method claims. It states:

This invention deals with an electrical cable consisting essentially of a material which is flowable at about 25°C and is a dielectric that does not substantially absorb moisture or swell upon contact with moisture (claim 1). This invention also deals with the method of making the cable and method of imparting to a cable, comprising the steps of forming a self-repairing material (i.e. inner layer) which is flowable at about 25°C and is a dielectric that does not substantially absorb moisture or swell upon contact with moisture (claims 10, 26, & 28). [These] claim limitations, along with other claim limitations, are not taught or suggested by the prior art of record

(Notice of Allowability, the '231 patent, § 5, p. 5). The '231 patent applicants did not contest the Examiner's characterization of all twenty-six claims in the singular as "[t]his invention."

Thus, the actions of both the '231 patent applicants and the Examiner indicate that the claimed methods are not patentably distinct from the claimed cable.

5. Additional Limitations in the Claims of the Present Application and the '231 Patent Do Not Make Those Claims Patentably Distinct

The dependent claims of the present application and the '231 patent are not patentably distinct from the independent claims of the proposed count. Recitations in these dependent claims include: (1) "the conductor is formed by a plurality of wires stranded together"; (2) "applying a water barrier material over the conductor before applying the self-sealing material in step (b)"; (3) "the water barrier is a polymer sheet"; (4) "the material is capable of at least partially [filling] the discontinuity without leaking from the cable in an uncontrolled manner"; (5) "said material is a polymeric material"; (6) "said material is substantially free of solvents and oils"; (7) "said material contains inert filler material"; (8) "said material has a

100 gram needle penetration value greater than 100 tenths of a millimeter at 25° C”; (9) “said material is an isomer”; (10) “said material is made from low molecular weight copolymers of an isomer”; and (11) “said material is made from isobutene copolymers”.

Forming a conductor as a plurality of wires stranded together, applying a water barrier material to a conductor before applying further coating layers, and the use of a polymer sheet as such a water barrier are well known in the art. Also, if the material has capacity, upon creation of discontinuity in the layer of insulation, of reestablishing continuity in the layer of insulation in a reversible manner, then the material must be capable of at least partially filling the discontinuity without leaking from the cable in an uncontrolled manner.

Applicants note that the proposed count specifically identifies polyisobutene as a material flowable at about 25 °C, which provides self-sealing properties to the cable, is a dielectric, and has capacity, upon creation of discontinuity in the layer of insulation, of reestablishing continuity in the layer of insulation in a reversible manner. It is known in the art that polyisobutene generally does not substantially absorb moisture or swell upon contact with moisture and that polyisobutene can have a low molecular weight. Also, it is known in the art that polyisobutene is a polymeric material, that polyisobutene can be substantially free of solvents and oils, and that polyisobutene can be combined with inert filler material. Further, it is known in the art that polyisobutene may have a 100 gram needle penetration value greater than 100 tenths of a millimeter at 25 °C (see, e.g., U.S. Patent No. 5,010,209 and Exhibit E).

Further, Applicants submit that the specific identification of polyisobutene, combined with the requirements that the material be flowable at about 25 °C, provide self-sealing properties to the cable, be a dielectric, and have capacity, upon creation of discontinuity in the

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layer of insulation, of reestablishing continuity in the layer of insulation in a reversible manner, would lead one of skill in the art to consider at least some isomers, low molecular weight copolymers of isomers, and isobutene copolymers.

Additionally, analogous to the discussion in Section V.B.4 above, by consistently treating all claims of the '231 patent as a single invention during prosecution, the actions of both the '231 patent applicants and the Examiner indicate that the dependent claims are not patentably distinct from the independent claims.

VI. At Least All Claims of the Present Application, the '473 Patent, and the '231 Patent Should Be Designated as Corresponding to the Count

All claims of the present application and the '473 patent are directed to subject matter that is patentably indistinct from each other and the proposed count, and should be designated as corresponding to the count. The claims of the present application and the '473 patent represent common, interfering subject matter, and the proposed count embraces that subject matter.

As further explained above, the variations in the claims of the '473 patent do not represent patentably distinct departures from the limitations in the proposed count. Accordingly, all claims of the '473 patent that have been identified in this Second SPA should be designated as corresponding to the count.

All claims of the present application and the '231 patent are directed to subject matter that is patentably indistinct from each other and the proposed count, and should be designated as corresponding to the count. The claims of the present application and the '231 patent represent common, interfering subject matter, and the proposed count embraces that subject matter.

As further explained above, the variations in the claims of the '231 patent do not represent patentably distinct departures from the limitations in the proposed count. Accordingly, all claims of the '231 patent that have been identified in this Second SPA should be designated as corresponding to the count.

Applicants note that the prosecution history file of the '533 application includes a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent ("Terminal Disclaimer") filed on November 29, 2001. Specifically, this Terminal Disclaimer disclaims the terminal part of the statutory term of the '231 patent which would extend beyond the expiration date of the statutory term of the earlier '473 patent. Such a Terminal Disclaimer strongly supports Applicants' request that the interference include both the '473 and '231 patents.

Finally, Applicants also note that the '766 application, which is the parent of the present application, is pending and may claim subject matter deemed at least relevant to the proposed count.

VII. The Benefit of Earlier Applications Should Be Accorded to Applicants When Declaring an Interference

Benefit of filing dates for interference purposes can be found in any prior application in which one embodiment of the count is described in a manner that complies with 35 U.S.C. § 112. In the present application, Applicants claim the benefit of two U.S. patent applications and one U.S. provisional patent application, and claim the right of priority of a European patent application.

The present application is a continuation of the '766 application, filed October 9, 2001 (Exhibit F). The '766 application is a continuation of the '505 application, filed March 3, 1999

(Exhibit G, abandoned). Through the '766 application and the '505 application, Applicants claim the benefit of the '752 provisional application, filed March 4, 1998 (Exhibits H/I, abandoned). Additionally, through the '766 application and the '505 application, Applicants claim the right of priority of the EP application, also filed March 4, 1998 (Exhibits J/K).

Support may be found in each of these antecedent priority applications for exemplary embodiments meeting all the limitations of the proposed count.

A. Exemplary Disclosures

Applicants note that the originally-filed specification, claims, abstract, and drawings of the present application, the '766 application, the '505 application, and the '752 provisional application are substantially identical.

Additionally, the originally-filed specification, claims, abstract, and drawings of the present application are also substantially identical to the originally-filed EP application.

Attached to this Second SPA are "Claim Chart—Part I" (Exhibit A) and "Claim Chart—Part II" (Exhibit B) that provide exemplary disclosures for the present application, the '766 application, the '505 application, the '752 provisional application, and the EP application.

B. Applicants Should Be Declared the Senior Party

The present application has an effective filing date of no later than March 4, 1998. The earliest U.S. application from which the present application claims benefit is the '752 provisional application (Exhibit H), filed March 4, 1998. An English-language translation of the '752 provisional application is attached (Exhibit I). As shown in "Claim Chart—Part I" (Exhibit A) and "Claim Chart—Part II" (Exhibit B), the '752 provisional application provides full support for copied claims 55-100.

Additionally, the present application claims the right of priority based on the EP application (Exhibit J), also filed March 4, 1998. An English-language translation of the EP application is attached (Exhibit K). Because the originally-filed specification, claims, abstract, and drawings of the present application are also substantially identical to the originally-filed EP application, the EP application also provides full support for copied claims 55-100.

The continuous chain of the '752 provisional application (Exhibits H/I), filed March 4, 1998, and/or the EP application (Exhibits J/K), also filed March 4, 1998; the '505 application (Exhibit G), filed March 3, 1999; the '766 application (Exhibit F), filed October 9, 2001; and the present application demonstrate that the present application is entitled to an effective filing date of no later than March 4, 1998.

In contrast, the '473 patent lists no potential U.S. (provisional or nonprovisional) or foreign priority date other than the January 11, 1999, filing date of the '482 application. Further, the prosecution history file of the '473 patent indicates: (1) "Continuing Domestic Data"—"Verified None"; (2) "371 (Nat'l Stage) Data"—"Verified None"; (3) "Foreign Applications"—"Verified None"; and (4) "Foreign Priority claimed"—"No." In a similar vein, the prosecution history file of the '473 patent indicates no information for "35 USC 119 (a-d) conditions met." Thus, the earliest potential effective filing date for the '473 patent is January 11, 1999.

Similarly, the '231 patent lists no potential U.S. (provisional or nonprovisional) or foreign priority date other than the January 11, 1999, filing date of the '482 application. Further, the prosecution history file of the '231 patent indicates: (1) "Continuing Domestic Data"—"THIS APPLICATION IS A DIV OF 09/228,482 01/11/1999 PAT 6,184,473"; (2) "Foreign Applications"—"None"; (3) "Foreign Priority claimed"—"No"; and (4) "35 USC 119 (a-d)

conditions met"—“No.” Thus, the earliest potential effective filing date for the '231 patent is also January 11, 1999.

Accordingly, Applicants are entitled to senior party status.

Lastly, because Applicants' effective U.S. filing date is before the earliest effective U.S. filing date of both the '473 and '231 patents, no showing pursuant to 37 C.F.R. § 1.608 is required.

VIII. The Requirements of 35 U.S.C. § 135(b) Are Satisfied

Applicants claimed the same or substantially the same subject matter as the claims of the '473 patent less than one year after the '473 patent issued. In particular, claims 55-73 of the present application are drawn to the same or substantially the same subject matter as the claims of the '473 patent, which issued on February 6, 2001, less than one year before the SPA was filed on January 29, 2002.

Additionally, Applicants claim the same or substantially the same subject matter as the claims of the '231 patent less than one year after the '231 patent issued. In particular, claims 74-100 of the present application are drawn to the same or substantially the same subject matter as the claims of the '231 patent, which issued less than one year ago on March 19, 2002.

Further, Applicants claimed the same or substantially the same subject matter as the claims of the '533 application less than one year after the '533 application was published. In particular, one or more of claims 1-73 of the present application are drawn to the same or substantially the same subject matter as the claims of the '533 application, which was published on May 24, 2001, less than one year before the present application and the SPA were filed on January 29, 2002.

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IX. Conclusion

In light of the above, Applicants respectfully submit that the pending claims in the present application are directed to allowable subject matter that is patentably indistinct from the claims of the '473 patent and the '231 patent. Applicants therefore request an interference based on the count proposed in this Second SPA.

Accordingly, Applicants request that the Examiner:

- (1) prepare and transmit the Forms PTO-850 (Interference Initial Memorandum) (proposed samples enclosed as Exhibit L) recommending that an Administrative Patent Judge institute one interference between the present application and the '473 patent, between the present application and the '231 patent, and between the present application and any pending patent applications that both claim the benefit of the '473 patent and/or the '231 patent and contain claims for the same patentable invention as the present application;
- (2) propose the count set forth in this Second SPA and designate the following claims as corresponding to the count: claims 55-100 of the present application, claims 1-18 of the '473 patent, claims 1-26 of the '231 patent, and relevant claims of any other related pending applications;
- (3) accord Applicants the benefit of each earlier-filed U.S. provisional patent application and patent application (Exhibits H/I, G, and F) and the right of priority of the earlier-filed European patent application (Exhibits J/K); and
- (4) designate Applicants as the Senior Party when the interference is declared.

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If there is any fee due in connection with the filing of this Second SPA, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: October 17, 2002

By: _____

Lawrence F. Galvin
Reg. No. 44,694

Attachments (Exhibits A-L)

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